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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,644	03/14/2001	Christen M. Anderson	660088.420D3	7397
500	7590	03/09/2005	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092			ANDERSON, REBECCA L	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/810,644

Applicant(s)

ANDERSON ET AL.

Examiner

Rebecca L. Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 94,96-102 and 108 is/are pending in the application.
- 4a) Of the above claim(s) 97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 94,96,98-102 and 103 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 94, 96-102 and 108 are currently pending in the instant application. Claim 97 is withdrawn from consideration as being for non-elected subject matter and claims 94, 96, 98-102 and 108 are objected.

***Response to Amendment and Arguments***

Applicants' amendment and arguments filed 7 December 2004 have been entered into the application. Applicants amendments to claims 94, 96 and 102 and the cancellation of claims 1-93, 95, 103-107 and 109-112 have overcome the 35 USC 102(b) rejections of claims 85, 86, 89, 93, 94, 96, 99, 101-103, 107 and 108 as being anticipated by Boulay et al., Block et al., or Roux et al. In regards to the claim objections, applicant argues that the further restriction as found on pages 2 and 3 of the previous office action which defines the elected and examined invention is improper according to MPEP 803.02, In re Weber, In re Harnisch and unity of invention. This argument is not found persuasive since, for essentially the same reasons as found in the last Office action, it is noted that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. Nowhere do applicants argue

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to the contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. So, here we have claims, which involve more than one independent or distinct invention. Under 35 U.S.C. 121, the claims may be restricted and the examination limited to a restricted invention. In traversing the restriction requirement of the intra-claim restriction, applicant has relied on the decision of *In re Weber*, 198 U.S.P.Q. 328 (CCPA 1978). However, this is considered non-persuasive because this decisions involved rejections of claims under 35 U.S.C. 121 and not a restriction as is the case herein. The issue here is one of restriction. Applicants' traversal of the restriction requirement is based on its intra-claim restriction. Again, it is noted that the restriction requirement here is predicated on the premise that the various compounds involved (i.e. the elected and non-elected compounds) differ in structure and element so much so as to be patentably distinct, i.e., a reference which anticipated but the elected compounds claimed would not even render obvious the others. Furthermore, applicant has argued a lack of unity standard, which does not address the premise of the restriction requirement. Notwithstanding that lack of unity is not the basis for this restriction requirement, a lack of unity standard requires that the claims contain a special technical feature that defines a contribution over the art. Here the claims are an ANT ligand which does not define a contribution over the art as can be seen by the various 102(b) rejections in the previous office action. Also, there has been no rejection made under improper Markush groups so *In re Harnisch*, cited by applicants, is not relevant here. So, here we have claims which involve more

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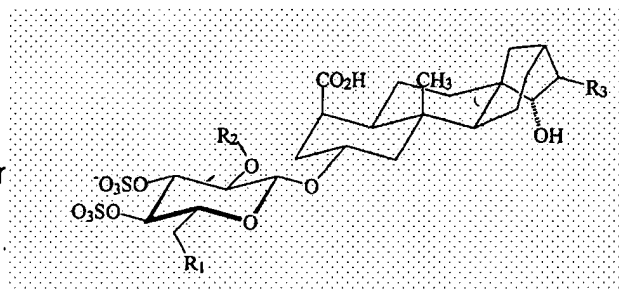
than one independent or distinct inventions. Under 35 USC 121, the claims may be restricted and the examination limited to a restricted invention. Accordingly, the requirement to restrict is considered proper and is maintained and is FINAL.

### ***Maintained Claim Objections***

Claims 94, 96, 98-102 and 108 are objected to as containing non-elected subject matter. Claims 94, 96, 98-102 and 108 presented drawn solely to the elected invention for search and examination as identified on pages 2 and 3 of the office action mailed 5 April 2004 would appear allowable over the prior art of record.

**The elected and examined invention is the ANT ligand having the following structure:**

and stereoisomers are



, wherein:

R1 is -OC(=O)(aryl),

l) or -

OC(=O)(substituted arylalkyl) wherein the substituents on the substituted aryl and substituted arylalkyl are selected from the group consisting of halogen, hydroxy, alkyl, haloalkyl, aryl and arylalkyl;

R2 is hydrogen or -C(=O)R5;

R3 is CH<sub>3</sub> or =CH<sub>2</sub> and

R5 is alkyl.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

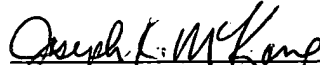
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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2/25/05



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